

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number:  07844-494001
	Application Number  10/072,382	Filed  February 6, 2002
	First Named Inventor  James D. Pravetz	
	Art Unit  2178	Examiner  Kyle R. Stork
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>57,520</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 50%; text-align: center;"> <p>_____ /Brenda M. Leeds Binder/ Signature</p> <p>_____ Brenda M. Leeds Binder Typed or printed name</p> <p>_____ (650) 839-5070 Telephone number</p> <p>_____ July 9, 2007 Date</p> </div> </div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.</p>		
<input checked="" type="checkbox"/> Total of 1 form is submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	James D. Pravetz	Art Unit :	2178
Serial No. :	10/072,382	Examiner :	Kyle R. Stork
Filed :	February 6, 2002	Conf. No. :	2559
Title :	DYNAMIC PREVIEW OF ELECTRONIC SIGNATURE APPEARANCE		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. This request is filed specifically in response to legal and factual deficiencies in the final Office Action mailed March 7, 2007. Nonetheless, all rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

The applicant respectfully submits the Examiner has failed to show a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations” [MPEP, §2143]. Even in combination, the two references fail to disclose all the limitations recited in claim 1. Claim 1 reads as follows:

1. A method for signing an electronic document, the method comprising:
  - establishing an electronic signature appearance for an electronic signature, the electronic signature appearance comprising a visual manifestation of a signer's signature on the electronic document and the electronic signature comprising code derived from a signed electronic document and a private key;
  - determining a bounding region on the electronic document for the display of the electronic signature appearance;
  - at the time of electronically signing the electronic document, previewing the electronic signature appearance in the bounding region, where the electronic signature appearance can be edited based on a user input after previewing the electronic signature appearance and before electronically signing the electronic document; and
  - signing the electronic document with the electronic signature, the electronic signature appearance being included in the electronic document signed with the electronic signature.

The Examiner rejected claim 1 under 35 U.S.C. 103(a) as being unpatentable over Microsoft® Outlook® 2000 (1999, hereinafter "Outlook"), and further in view of the Applicant's Admitted Prior Art (Specification, filed Feb 6, 2002, hereinafter "AAPA"). The Examiner asserts that Outlook discloses a method for signing an electronic document that includes all of the limitations of claim 1, other than "the electronic signature comprising code derived from a signed electronic document and a private key". With respect to the above limitation, which is a clarification of the term "electronic signature" as defined and used within the specification, the Examiner relies on the AAPA, wherein the applicant describes a conventional public-private key implementation of an electronic signature (Specification, p. 1, ll. 9-17). The Examiner asserts it would have been obvious to have combined the AAPA with Outlook.

The applicant respectfully submits that even if the AAPA is combined with Outlook, the combined references do not teach or suggest all of the claim limitations. Claim 1 recites a method for signing an electronic document. In particular, the claim provides for establishing an electronic signature appearance for an electronic signature. In reading the claim, the difference between the appearance and the actual digital signature (termed "electronic signature" in the claim) must be kept in mind. The electronic signature "comprises code derived from a signed electronic document and a private key", whereas the electronic signature appearance includes "a visual manifestation of a signer's signature". With those definitions in mind, it should be clear that the electronic signature appearance, *i.e.*, the visual manifestation, can be previewed before the document is electronically signed, that is, before the electronic signature including the code derived from the signed electronic document and a private key is generated. This is an advantage of the method recited in claim 1, because a person electronically signing a document can preview the electronic signature *appearance* in the bounding region before the document is electronically signed and if not satisfied with the electronic signature appearance, the person can edit the electronic signature appearance. Otherwise, without a preview feature as recited, the person would not have an opportunity to view the electronic signature appearance within the bounding region until the electronic document was already electronically signed, and if

dissatisfied would have to re-sign another copy of the electronic document and discard or destroy the first signed electronic document.

The Examiner provided screenshots in Figures 1-5 from Outlook illustrating Outlook's "signature" feature, wherein a user can create a "signature" that is displayed within an email message prepared by the user in Outlook. Once created, the signature can be stored and reused, and can be automatically applied by Outlook to outgoing email messages generated by the user in Outlook.

The applicant respectfully submits the Examiner has misunderstood the important difference between an electronic signature and an electronic signature appearance. The signature feature shown in Figures 1-5 provided by the Examiner illustrate a signature *appearance* feature provided by Outlook. That is, the Outlook signature includes text and/or graphical images and provide an appearance of a signature; however, the claim calls for an appearance of an electronic signature. Further, using the signature feature shown in Figures 1-5, the Outlook email message is not "electronically signed" nor is an "electronic signature" created, as those terms are known in the art and used and defined within the specification in some detail. As discussed above, the difference between an electronic signature appearance and an electronic signature must be kept in mind, as these terms are fundamental to understanding the method recited in claim 1. The Outlook signature feature shown in Figures 1-5 simply does not provide for an electronic signature; there is no electronic signing of a document.

The AAPA does not cure the deficiency of the Outlook reference. The AAPA describes a conventional electronic signature implementation. However, there is no disclosure of previewing of an electronic signature appearance in a bounding region, and no ability to then edit the electronic signature appearance after previewing but before electronically signing the document.

Accordingly, since the references combined do not teach or suggest all limitations of claim 1, a *prima facie* case of obviousness has not been established. Claim 17, a computer program product claim, similarly requires previewing an electronic signature appearance in a bounding region and the ability to then edit the electronic signature appearance after previewing

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but before electronically signing the document. Accordingly, claim 17 is also not obviousness in view of Outlook combined with the AAPA.

The rejections of record are clearly improper and without basis and should be withdrawn. Moreover, it is respectfully submitted that all of the claims are in condition for allowance, and a notice of allowance is respectfully requested.

Please apply the notice of appeal fee (\$500), the petition for one-month extension of time fee (\$120), and any other necessary charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: July 9, 2007 \_\_\_\_\_

/Brenda M. Leeds Binder/\_\_\_\_\_  
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